REMARKS/ARGUMENTS

The Office Action of September 20, 2005 has been carefully reviewed and these remarks are responsive thereto. Claims 1, 10, 17, 24, 31, and 36 have been amended, no claims have been cancelled, and no new claims have been added. Claims 1-55 thus remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-55 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Appl. Publ. No. US 2003/0225796 A1 to Matsubara (hereinafter *Matsubara*) in view of U.S. Patent Appl. Publ. No. 2002/0033844 A1 to Levy et al. (hereinafter *Levy*).

The References Do Not Teach All the Claimed Features

Applicants have amended claim 1 to recite a method including, "executing on the sharer's computer a query comprising a scope and a criteria," and "creating on the sharer's computer a list with a plurality of referenced items based on the results of said query." Neither *Matsubara* nor *Levy*, nor the proposed combination of the two, teaches or suggests executing a query to determine which files are to be shared by the sharer. In *Matsubara*, sharers must "drag and drop" individual files into the NRB browser to create a file link in the central server. *Matsubara*, figure 9, block 902; paragraph 0070. Similarly, in peer-to-peer (P2P) file sharing systems, such as the system disclosed by *Levy*, files are not shared based on the results of a query, but rather simply based on the physical directory in which they are stored on the sharer's machine. As stated in *Levy*, paragraph 0190, "[t]he file sharing is usually restricted to a certain file type, such as music or videos, and to a certain directory." Indeed, *Levy* never discloses or even suggests the use of a query to determine which files to share. Thus, neither *Matsubara* nor *Levy*, nor the proposed combination of the two, teaches or suggests, "executing on the sharer's computer a query comprising a scope and a criteria," or "creating on the sharer's computer a list with a plurality of referenced items based on the results of said query," as recited in claim 1. Accordingly, amended claim 1 is not obvious under 35 U.S.C. § 103(a) over *Matsubara* and

Levy. Dependent claims 2-9, 43-44, and 49 are allowable for at least the same reasons as claim 1, as well as based on the additional features recited therein.

Applicants have similarly amended independent claims 10, 17, 24, 31, and 36 to describe a methods and computer-readable media for sharing files "based on the results of a query." Since neither *Matsubara* nor *Levy* discloses executing a query to determine the list of files to be shared, neither these references nor their proposed combination teaches or suggests sharing files "based on the results of a query," as recited in independent claims 10, 17, 24, 31, and 36. These independent claims are thus not obvious under 35 U.S.C. § 103(a) in view of the cited references. Dependent claims 11-16, 18-23, 25-30, 32-35, 37-42, 45-48, and 50-55 are allowable for at least the same reasons as their respective base claims, as well as based on the additional features recited therein.

With regard to claims 5-7, 13-14, 20-21, 27-28, 32-33, and 40-42, neither *Matsubara* nor *Levy*, nor the proposed combination of the two, teaches or suggests creating a dynamic list of sharable items. As correctly indicated in the Office Action, *Matsubara* does not teach wherein the list is a dynamic list. Office Action, page 5, lines 8-10. However, the Office Action alleges that "Levy teaches dynamic lists of HTML files (section 0056)". Office Action, page 5, line 11. The Applicants respectfully disagree with this characterization of *Levy*. *Levy*, paragraph 0056, states:

> Microsoft's dynamic HTML provides an interface that allows an Internet Explorer listener program to insert code to modify an HTML document. Using this interface, the listener program inserts a Java script that controls the display and responds to input to the logo superimposed on the image shown in FIG. 3.

Thus, Levy never discloses or suggests a dynamic list. *Levy* merely refers to dynamic HTML, a well-known term of art describing an extension of the HTML programming language used to support interactive web pages. Dynamic lists, an entirely distinct concept from dynamic HTML, are discussed at length in the instant application. For example:

> If any items in the dynamic list have their properties changed such that they no longer meet the criteria of the dynamic list, then these items are appropriately re-permissioned. In the same way, if any items that do not belong to the dynamic list change such that they fall into the scope and

> meet the criteria of the dynamic list, they are also re-permissioned to grant access to the users with which the dynamic list is shared.

Specification, page 4, line 22 to page 5, line 2. Thus, since neither *Matsubara* nor *Levy*, nor the proposed combination of the two, teaches or suggests a "dynamic list," as recited in claims 5-7, 13-14, 20-21, 27-28, 32-33, and 40-42, these claims are not obvious under 35 U.S.C. § 103(a) in view of *Matsubara* and *Levy*.

With respect to claims 43, 45, and 47, neither *Matsubara* nor *Levy* teaches an order for a list of shared items. The Office Action alleges that *Matsubara* teaches an "access control list containing an ordered list of rules and providing to limit access to a file." Office Action, page 19, lines 8-9. Applicants respectfully disagree. *Matsubara* never discloses an "ordered list of rules." Indeed, the terms "order" and "ordered" are never found in *Matsubara*. Further, even if *Matsubara* had disclosed an ordered list of rules in the access control list, it would still not teach an order for the shared items themselves. Thus, since neither *Matsubara* nor *Levy*, nor the proposed combination of the two, teaches or suggests a "defining within the list an order," as recited in claim 43, or "a predefined order of the referenced items," as recited in claims 45 and 47, these claims are not obvious under 35 U.S.C. § 103(a) in view of the cited references.

Lack of Motivation to Combine Matsubara with Levy

In order to reject a claim as obvious under § 103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. *See* MPEP § 706.02 (j).

However, there is no motivation or suggestion to combine *Matsubara* with *Levy*. The Office Action states that it would have been obvious to combine the references to "utilize the use of a list of files on the sharable directory over the network in the P2P environment (Levy's sections 0047-0048), into the system of Matsubara for the purpose of search objects of files in the P2P file sharing system (Levy's section 0065)." Office Action, page 4, lines 7-10. This is not a motivation to combine references, however, but rather is the conclusion the examiner has apparently reached after having benefited from reading Applicants' own disclosure, and is thus

impermissible hindsight. In fact, the teachings of *Matsubara* and *Levy* are clearly divergent and implicitly teach away from one another. To add *Matsubara's* system server to *Levy*, and to require all sharers and sharees to first interact with the system server before accessing their P2P counterpart, as does *Matsubara*, would defeat the intended purpose of *Levy's* decentralized P2P file sharing system. Similarly, to add the shared file list on the sharer's computer of *Levy* to the *Matsubara* system would necessarily create redundant virtual directories, one centralized virtual directory on the system server and a corresponding virtual directory on each sharer's computer. These redundant virtual directories would seemingly serve no purpose, and would only hinder *Matsubara's* stated goal of simplified sharing in a P2P system. *Matsubara*, paragraph 0009. Accordingly, withdrawal of the § 103(a) rejections of claims 1-55 is respectfully requested.

CONCLUSION

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

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Dated this 20 day of Dec., 2005.

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